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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,187	02/04/2002	John Walter Liebeschuetz	00219/US	8364

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UNITED KINGDOM

EXAMINER

HABTE, KAHSAY

ART UNIT	PAPER NUMBER
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1624

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DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/030,187

Applicant(s)

LIEBESCHUETZ ET AL.

Examiner

Kahsay Habte, Ph. D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 19-27, 30 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-16, 19-27, 30 and 33-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-16 (in part), 19-21 (in part), 23-25 (in part), 27 (in part), 30 (in part), and 33 (in part), drawn to Cy = pyrimidinyl.

Group II, claim(s) 1-16 (in part), 19-25 (in part), 27 (in part), 30 (in part), and 33 (in part), drawn to Cy = pyridinyl or piperidinyl.

Group III, claim(s) 1-16 (in part), 19-21 (in part), 23-25 (in part), 27 (in part), 30 (in part), and 33 (in part), drawn to Cy = thiadiazoles.

Group IV, claim(s) 1-16 (in part), 19-25 (in part), 27 (in part), 30 (in part), and 33 (in part), drawn to Cy = pyrazoles and imidazoles.

Group V, claim(s) 1-16 (in part), 19-25 (in part), 27 (in part), 30 (in part), and 33 (in part), drawn to Cy = oxazoles and thiazoles.

Group VI, claim(s) 1-16 (in part), 19-25 (in part), 30 (in part) and 33 (in part), drawn to Cy = furans and thiophenes.

Group VII, claim(s) 1-16 (in part), 19-21 (in part), 23-25 (in part), 27 (in part), 30 (in part), and 33 (in part), drawn to Cy = pyrroles.

Group VIII, claim(s) 1-16 (in part), 19-25 (in part), 26, 27 (in part), 30 (in part), and 34-36, drawn to Cy = phenyl (non-heterocyclic ring).

Group IX, claim(s) 1-16 (in part), 19-25 (in part), 27 (in part), 30 (in part) and 33 (in part), drawn to Cy = others (e.g. polycyclic rings; or rings that do not fall within Groups I-VIII).

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2. The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the technical features for example of Group I is pyrimidinyl ring (six-membered ring with 2 nitrogens at 1,3 position) and is different from Groups II-Groups IX. The technical feature of Group II is pyridinyl ring (6-membered ring with one nitrogen), the technical feature of Group III is thiadiazole ring (5-membered ring with 2 nitrogens and sulfur), etc. The technical feature of each Group is different one from the other. Group IX is drawn to compounds that don't fall in Groups I-VIII.

Note that claim 1 is unsearchable and further restriction may be needed. If applicants elected Group IX, a tentative election of species is required.

3. A telephone call was not made because applicant's representative is located abroad.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (703) 308-4717. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Kahsay Habte, Ph. D.
Examiner
Art Unit 1624



Mukund J. Shah
Supervisory Patent Examiner
Art Unit 1624

KH
May 2, 2003